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EXAMINER
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KHOSHNOODI, NADIA

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/683,943	Applicant(s) PARMELEE ET AL	
	Examiner Nadia Khoshnoodi	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Response to Arguments from Pre-Brief Appeal Conference Request***

Applicants Applicant's arguments in the pre-brief conference request with respect to amended claims 18 & 27, previously presented claims 1-17, 19-26, & 28-32, and newly presented claims 33-41 filed 3/31/2005 have been fully considered. Prosecution has been re-opened due to the fact that the Applicants contended that the provisional application of the Wheeler et al. reference was not supportive of paragraphs [108]-[118], [120], [129]-[132], [145], [170], [172], and [182]-[190]. Thus, the Examiner has reviewed the provisional application to point out where the elements relied upon in the Wheeler et al. publication are supported in the provisional application.

As per Paragraph [108]:

The Wheeler et al. portions relied upon, i.e. lines 4-9 and 12-15, are supported on pages 5-6 of the "Aads" portion of the provisional.

As per Paragraph [109]:

The Wheeler et al. portions relied upon, i.e. lines 1-5 and 9-11, are supported on page 6 of the "Aads" portion of the provisional and on page 1 of the "Aadsstraw" portion of the provisional.

As per Paragraph [110] – [113]:

The Wheeler et al. portions relied upon, i.e. par. 113 lines 8-12, are supported on page 6 of the "Rachip" portion of the provisional. Furthermore, par. 113 lines 12-18, are supported on pages 1-3 of the "Aadsstraw" portion of the provisional.

As per Paragraph [114]:

The Wheeler et al. portions relied upon, i.e. lines 6-16, are supported on page 5 of the “Aadsstraw” portion of the provisional.

As per Paragraph [115]:

The Wheeler et al. portions relied upon, i.e. lines 9-20, are supported on pages 12-13 of the “Aadsstraw” portion of the provisional and on page 2 of the “Aadsbrnd” portion of the provisional.

As per Paragraph [117]:

The Wheeler et al. portions relied upon, i.e. lines 1-5 and 9-11, are supported on page 6 of the “Aads” portion of the provisional and on page 1 of the “Aadsstraw” portion of the provisional.

As per Paragraph [118]:

The Wheeler et al. portions relied upon, i.e. lines 1-38, are supported on page 13 of the “Aadsstraw” portion of the provisional. Support of multiple accounts is evident based on the fact that the provisional allows for multiple applications in correspondence with a public key.

As per Paragraph [120]:

The Wheeler et al. portions relied upon, i.e. lines 1-13, are supported on page 13 of the “Aadsstraw” portion of the provisional.

As per Paragraph [129]:

The Wheeler et al. portions relied upon, i.e. lines 1-5, are supported on page 6 of the “Aads” portion of the provisional.

As per Paragraphs [130]-[131]:

The Wheeler et al. portions relied upon, i.e. lines 10-24, are supported on pages 3 & 6 of the “Aadsstraw” portion of the provisional and on page 2 of the “Rachip” portion of the provisional.

As per Paragraph [132]:

The Wheeler et al. portions relied upon, i.e. lines 1-12 are supported on page 2 of “Aadsbrnd” portion of the provisional and on page 6 of the “Aadsstraw” portion of the provisional.

As per Paragraph [145]:

The Wheeler et al. portions relied upon, i.e. lines 1-6, are supported on page 1 of the “Aadsstraw” portion of the provisional.

As per Paragraph [170]:

The Wheeler et al. portions relied upon, i.e. lines 1-12, are supported on pages 3-6 of the “Aadsstraw” portion of the provisional.

As per Paragraph [172]:

The Wheeler et al. portions relied upon, i.e. lines 1-13, are supported on page 6 of the “Aadsstraw” portion of the provisional.

As per Paragraph [182]-[183]:

The Wheeler et al. portions relied upon, i.e. par. 183 lines 1-12, are supported on page 3 of the “Aads” portion of the provisional. Furthermore, par 183 lines 12-18 are supported on page 6 of the “Aadsstraw” portion of the provisional.

As per Paragraph [184]:

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The Wheeler et al. portions relied upon, i.e. lines 4-6, are supported on page 5 of the “Aads” portion of the provisional. Furthermore, lines 6-18 are supported on pages 13-14 (from the bottom of page 13) of the “Aadsstraw” portion of the provisional.

As per Paragraph [185]:

The Wheeler et al. portions relied upon, i.e. lines 1-11, are supported on page 12 of the “Aadsstraw” portion of the provisional.

As per Paragraph [186]:

The Wheeler et al. portions relied upon, i.e. lines 1-5, are supported on pages 12-13 (from the bottom of page 12) of the “Aadsstraw” portion of the provisional.

As per Paragraph [187]:

The Wheeler et al. portions relied upon, i.e. lines 1-17, are supported on page 12 of the “Aadsstraw” portion of the provisional.

As per Paragraph [188]:

The Wheeler et al. portions relied upon, i.e. lines 1-8, are supported on pages 4-5 (from the bottom of page 4) of the “Aadsstraw” portion of the provisional.

As per Paragraph [189]:

The Wheeler et al. portions relied upon, i.e. lines 9-15, are supported on page 1 of the “Aadsstraw” portion of the provisional.

As per Paragraph [190]:

The Wheeler et al. portions relied upon, i.e. lines 1-8, are supported on page 6 of the “Aadsstraw” portion of the provisional and pages 1-2 of the “Aadsbrnd” portion of the provisional.

Applicants further contend that the provisional application of the Meurer reference was not supportive of paragraph [013]. Thus, the Examiner has reviewed the provisional application to point out where the elements relied upon in the Wheeler et al. publication are supported in the provisional application.

As per Paragraph [013]:

The Meurer portion relied upon is supported on pages 42-43 of the provisional application.

Based on the above details listing it is evident that each of the paragraphs relied upon are supported by specific details as set forth in their corresponding provisional applications. Thus, the non-final rejection as set forth in the previous office action has been maintained in light of the cited pages which show that the provisional date is effective. Furthermore, the provisional applications of each of the references relied upon has been cited and mailed along with this office action to ensure that the Applicants are able to review the cited portions.

### *Claim Objections*

Claims 1-5, 9-11, 13-15, 18, and 31-32 are objected to because of the following informalities:

These claims use the acronym "ATM" where when using an acronym in a claim, Applicants must first spell out what the acronym stands for and can then use the acronyms for latter references made. For example, in each of the independent claims that use "ATM" Applicants can rewrite the first reference to an "ATM" to include "automated transaction machine (ATM)."

*Claim Rejections - 35 USC § 103*

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 1-6, 8-11, 15-16, 19, 27-29, 33-39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575 and further in view of Cohen, WO 00/55793.

As per claim 1:

Wheeler et al. substantially teach an apparatus comprising: at least one computer processor; and at least one data store in operative connection with the computer processor, wherein the at least one data store includes a plurality of digital accounts stored therein, wherein each of the digital accounts is associated with at least one private key (par. 113), wherein the computer processor is operative to communicate with a plurality of ATMs, wherein the computer processor is operative responsive to at least one of the ATMs to cause a digital signature to be produced for an electronic document responsive to the private key associated with one of the digital accounts (par. 109).

Not explicitly disclosed is a digital safe deposit account. However, Cohen teaches the use of an electronic safety deposit box. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. for the digital account to be a digital safe deposit account. This modification would have been obvious



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because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Cohen on page 12, lines 7-14.

As per claim 2:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 1. Not explicitly disclosed is wherein the computer processor is operative to receive the electronic document from the at least one ATM, wherein the computer processor is operative to store the electronic document in the data store in association with the one digital safe deposit account. However, Wheeler et al. teach that the electronic document may be stored. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to store the electronic document in the data stored in association with the one digital safe deposit account. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Wheeler et.al. in par. 170.

As per claim 3:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 2 above. Furthermore, Cohen et al. teach the apparatus wherein the computer processor is operative to retrieve the electronic document from the data store and send the electronic document to any one of the plurality of ATMs (page 12, lines 7-14).

As per claim 4:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 2. Furthermore, Wheeler et al. teach wherein the computer processor is operative to encrypt and

decrypt the electronic document stored in the at least one data store responsive to a secret key received from the at least one ATM (par. 117).

As per claim 5:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Furthermore, Wheeler et al. teach the apparatus wherein each digital safe deposit account is associated with a financial account number, wherein the computer processor is operative to access the private key associated with the one digital safe deposit account responsive to a message received from the at least one ATM which includes a financial account number that corresponds to the financial account number associated with the one digital safe deposit account (par. 189-190).

As per claim 6:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 5 above. Furthermore, Wheeler et al. teach the apparatus wherein the at least one financial account number corresponds to a credit card number (par. 183).

As per claim 8:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to maintain and store in the at least one data store, an access log in association with each digital safe deposit account (par. 120).

As per claim 9:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Furthermore, Wheeler et al. teach the apparatus wherein the at least one ATM includes a cash

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dispenser, wherein the computer processor is operative through communication with a financial transaction processing system to cause a dispense of cash from the cash dispenser to be authorized (par. 183).

As per claim 10:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to cause a new digital safe deposit account to be created in the data store responsive to communication from the at least one ATM (par. 129-132).

As per claim 11:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 10. Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to cause a new private key and a corresponding public key to be produced responsive to communication from the at least one ATM, wherein the computer processor is operative to store the private key in association with the new digital safe deposit account (par. 108-113).

As per claim 15:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 1. Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to receive a one-way hash of the electronic document from the at least one ATM, wherein the computer processor is operative to cause the digital signature to be generated responsive to the one-way hash and the private key (par. 145).

As per claim 16:

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Wheeler et al. and Cohen substantially teach the apparatus according to claim 1. Not explicitly disclosed is wherein the computer processor is operative to cause a second digital signature to be produced for the electronic document responsive to a private key that is not associated with the one digital safe deposit account. However, Wheeler et al. teach that there can be more than one account per person and that each account can have its own public/private key pair. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to have a second signature that is associated with another account. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Wheeler et al. in par 118.

As per claim 19:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Furthermore, Wheeler et al. wherein the computer processor is operative to cause a digital time stamp to be produced and attached to the electronic document (par. 172).

As per claim 27:

Wheeler et al. substantially teach a method comprising: a) receiving a request from an automated transaction machine to digitally sign an electronic document visually displayed by the automated transaction machine, wherein the request includes an account number that is associated with a digital account; b) accessing a private key associated with the digital account responsive to the account number; and c) producing a digital signature for the electronic document responsive to the private key; and d) causing the digital signature to be attached to the electronic document (par. 190).

Not explicitly disclosed is a digital safe deposit account. However, Cohen teaches the use of an electronic safety deposit box. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. for the digital account to be a digital safe deposit account. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Cohen on page 12, lines 7-14.

As per claim 28:

Wheeler et al. and Cohen substantially teach the method as applied to claim 27 above. Furthermore, Wheeler et al. teach the method, further comprising: e) storing a digitally signed copy of the electronic document in a data store in association with the digital safe deposit account (par 170).

As per claim 29:

Wheeler et al. and Cohen substantially teach the method as applied to claim 27 above. Furthermore, Wheeler et al. teach the method, wherein in step (a) the account number corresponds to a financial account number (par. 183).

As per claim 30:

Wheeler et al. and Cohen substantially teach the method as applied to claim 27 above. Furthermore, Wheeler et al. teach the method, further comprising: e) dispensing cash from the automated transaction machine (par. 184).

As per claims 33 and 41:

Wheeler et al. substantially teach a method and computer readable media with instructions comprising a) receiving, data associated with a financial account; b) responsive to

the data associated with the financial account received in (a), causing through operation, a private key which corresponds to the data associated with the financial account received in (a) to be accessed from at least one data store in operative connection with a computer processor, wherein the private key was previously stored in the at least one data store in correlated relation with the data associated with the financial account; c) causing through operation of a computer processor, a digital signature to be produced for an electronic document responsive to the private key accessed in (b); and d) causing through operation of the computer processor, the digital signature to be attached to the electronic document (par. 190).

Not explicitly disclosed is a server for carrying out these operations. However, Cohen teaches that these operations can be carried out via a server. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to carry out the operations on a server instead of a smart card with a processor. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Cohen on page 16, line 32 – page 17, line 5.

Also not explicitly disclosed is causing through operation of the server, the digital signature to be attached to the electronic document during or after the display of the electronic document through a display device viewable by a customer associated with the financial account. However, Wheeler et al. teach, in another embodiment, that the ATM has a display window so that customers can choose from the possible operations. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to also visually display the message with the attached signature, which includes

the operation chosen. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Wheeler et al. in par. 188-189.

As per claim 34:

Wheeler et al. and Cohen substantially teach the method of claim 33. Furthermore, Wheeler et al. teach the method wherein (a) the data associated with the financial account is representative of a financial account number (par. 183).

As per claim 35:

Wheeler et al. and Cohen substantially teach the method of claim 34. Furthermore, Wheeler et al. teach the method wherein (a) the at least one financial account number corresponds to at least one of a credit card number, a debit card number, and a bank account number (par. 183).

As per claim 36:

Wheeler et al. and Cohen substantially teach the method of claim 34. Furthermore, Wheeler et al. teach the method wherein (a) the data representative of the financial account number is received by the at least one server from and automated transaction machine in operative communication with the at least one server through a network (par. 114), wherein in (d) the automated transaction machine includes a display (par. 188).

As per claim 37:

Wheeler et al. and Cohen substantially teach the method of claim 36. Furthermore, Wheeler et al. teach the method wherein (a) the automated transaction machine includes a cash dispenser (par. 183).

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As per claim 38:

Wheeler et al. and Cohen substantially teach the method of claim 33. Furthermore, Wheeler et al. teach the method e) receiving with the at least one server, the electronic document; f) causing through operation of the at least one server the electronic document to be stored in the at least one data store in correlated relation with the data associated with the financial account received (par. 170).

As per claim 39:

Wheeler et al. and Cohen substantially teach the method of claim 38. Furthermore, Wheeler et al. teach the method further comprising g) subsequent to (f) receiving with the at least one server, data associated with the financial account from a remote computer in operative communication with the at least one server through a network (par. 114). Furthermore, Cohen teaches h) causing through operation of the at least one server the electronic document accessed from the at least one data store responsive to the data associated with the financial account received in (g); I) causing through operation of the at least one server, the electronic document to be communicated to the remote computer (page 12, lines 7-14).

III. Claims 7, 12-14, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575 and Cohen, WO 00/55793 as applied to claims 1 and 11 above, and further in view of Randle et al., United States Patent No. 5,974,146.

As per claim 7:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 1. Not explicitly disclosed is wherein each digital safe deposit account is associated with at least one digital certificate, wherein the computer processor is operative to cause the digital signature and



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at least one of the digital certificates associated with the one digital safe deposit account to be attached to the electronic document. However, Randle et al. teach that customers can gain access to resources by using a certificate related to the account. Furthermore, it is well known that a certificate is used to bind an identity to a public key. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to cause a digital certificate to be generated and stored in association with the digital safe deposit account. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Randle et al. in col. 11, lines 20-38.

As per claim 12:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 11. Not explicitly disclosed is wherein the computer processor is operative to cause a digital certificate to be generated and stored in association with the new digital safe deposit account, wherein the digital certificate includes the public key. However, Randle et al. teach that customers can gain access to resources by using a certificate related to the account. Furthermore, it is well known that a certificate is used to bind an identity to a public key. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to cause a digital certificate to be generated and stored in association with the digital safe deposit account. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Randle et al. in col. 11, lines 20-38.

As per claim 13

Wheeler et al. and Cohen substantially teach the apparatus according to claim 12.

Furthermore, Wheeler et al. teach wherein the computer processor is operative to receive a financial account number from the at least one ATM, wherein the computer processor is operative to store the financial account number in association with the new digital safe deposit account (par. 184-185).

As per claim 14:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 13 above.

Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to receive a password input from the at least one ATM, wherein the computer processor is operative to store the password input in association with the new digital safe deposit account (par. 187).

As per claim 40:

Wheeler et al. and Cohen substantially teach the method of claim 33. Not explicitly disclosed is e) causing through operation of the at least one server at least one digital certificate associated with the private key to be accessed from the at least one data store, wherein the at least one digital certificate was previously stored in the at least one data store in correlated relation with the data associated with the financial account; and f) causing through operation of the at least one server, the at least one digital certificate to be attached to the electronic document during or after the display of the electronic document through the display device.

However, Randle et al. teach that customers can gain access to resources by using a certificate related to the account. Furthermore, it is well known that a certificate is used to bind an identity to a public key. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to access the

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digital certificate that was previously stored in association with the account, as well as to display the document with the attached digital certificate. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Randle et al. in col. 11, lines 20-38.

IV. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575 and Cohen, WO 00/55793 as applied to claim 1 above, and further in view of Meurer, United States Patent Application Publication No. 2004/0215566.

As per claim 17:

Wheeler et al. and Cohen substantially teach the apparatus as applied to claim 1 above. Not explicitly disclosed is the apparatus wherein the computer processor is operative to cause a digital signature processing fee to be assessed to a financial account in response to causing the digital signature to be produced for the electronic document. However, Meurer teaches assessing a processing fee collected for processing transactions. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to cause a digital signature processing fee to be assessed to a financial account in response to producing the digital signature for the electronic document. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Meurer in paragraph 13.

As per claim 18:

Wheeler et al. and Cohen substantially teach the apparatus according to claim 16. Furthermore, Wheeler et al. teach the apparatus wherein the computer processor is operative to receive information about the financial account from the at least one ATM (par. 190).

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V. Claims 20-21, 23, 25-26, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575.

As per claim 20:

Wheeler et al. substantially teach a method comprising: b) accessing a private key and c) enabling an electronic document displayed by the automated transaction machine to be digitally signed with the private key (par. 190).

Not explicitly disclosed in that embodiment is a) receiving a financial account number from an automated transaction machine and b) accessing a private key associated with the financial account number. However, in another embodiment, Wheeler et al. teach that an account number is needed in order to utilize the public/private key pair. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to receive an account number in order to access the private key associated with the account number in that embodiment as well. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Wheeler et al., par. 113.

As per claim 21:

Wheeler et al. substantially teach the method, as applied to claim 20 above. Furthermore, Wheeler et al. teach the method wherein prior to step (c) further comprising: d) receiving a password from the automated transaction machine; and e) verifying that the password corresponds to a valid password previously associated with the financial account number (par. 187).

As per claim 23:

Wheeler et al. substantially teach the method, as applied to claim 20 above. Furthermore, Wheeler et al. teach the method, further comprising: d) storing a digitally signed copy of the electronic document in a digital safe deposit account in association with the financial account number (par. 170).

As per claim 25:

Wheeler et al. substantially teach the method as applied to claim 20 above. Furthermore, Wheeler et al. teach the method further comprising: d) enabling the electronic document to be digitally time stamped (par. 172).

As per claim 26:

Wheeler et al. substantially teach the method as applied to claim 20 above. Furthermore, Wheeler et al. teach the method, further comprising: d) dispensing cash from the automated transaction machine (par. 183).

As per claim 31:

Wheeler et al. substantially teach a method comprising: a) receiving a request at an ATM to digitally sign an electronic document; b) causing a digital signature and a digital time stamp to be produced for the electronic document; and c) causing the digital signature and the digital time stamp to be attached to the electronic document (par. 115).

Not explicitly disclosed in that embodiment is a) receiving a request at an ATM to digitally sign an electronic document visually displayed by the ATM. However, Wheeler et al. teach, in another embodiment, that the ATM has a display window so that customers can choose from the possible operations. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to also visually

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display the message to be signed, which includes the operation chosen. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Wheeler et al. in par. 188-189.

As per claim 32:

Wheeler et al. substantially teach the method as applied to claim 31 above. Furthermore, Wheeler et al. teach the method, further comprising: e) dispensing cash from the ATM (par. 184).

VI. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575 as applied to claim 20 above, and further in view of Randle et al., United States Patent No. 5,974,146.

As per claim 22:

Wheeler et al. substantially teach the method according to claim 20. Not explicitly disclosed is further comprising: d) accessing a digital certificate previously associated with the financial account number; wherein the digital certificate includes a public key that corresponds to the private key, wherein the public key is capable of being used to validate the digital signature; and e) enabling the digital certificate to be associated with the electronic document. However, Randle et al. teach that customers can gain access to resources by using a certificate related to the account. Furthermore, it is well known that a certificate is used to bind an identity to a public key. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to be able to access a digital certificate associated with the account in order to authenticate the entity's digital signature and to further

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associate the electronic document with that certificate. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Randle et al. in col. 11, lines 20-38.

VII. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler et al., United States Pub. No. 2002/0026575 as applied to claim 20 above, and further in view of Meurer, United States Patent Application Publication No. 2004/0215566.

As per claim 24:

Wheeler et al. substantially teach the method, as applied to claim 20 above. Furthermore, Wheeler et al. teach the method, further comprising: d) receiving a second financial account number from the automated transaction machine (par. 118). Not explicitly disclosed is the method further comprising, e) assessing a processing fee associated with the digital signing of the electronic document to a financial account associated with the second financial account number. However, Meurer teaches assessing a processing fee collected for processing transactions. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Wheeler et al. to cause a digital signature processing fee to be assessed to a financial account in response to producing the digital signature for the electronic document. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Meurer in paragraph 13.

*\*Reference Cited, Not Used*


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. United States Patent No. 5,650,604, as well as United States Patent No. 6,098,053 are cited because it is relevant due to the manner in which the invention has been claimed.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nadia Khoshnoodi  
Examiner  
Art Unit 2137  
4/18/2006

NK

  
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SUPERVISORY PATENT EXAMINER